



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/956,989	09/21/2001	Toni Markus Piponius	110686	2944

25944 7590 10/11/2005

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

LAZARO, DAVID R

ART UNIT PAPER NUMBER

2155

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/956,989

Applicant(s)

PIPONIU ET AL.

Examiner

David Lazaro

Art Unit

2155

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 1-22, 24, 25, 27 and 28.
Claim(s) withdrawn from consideration: _____.


AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.


SALEH NAJJAR
SUPERVISORY PATENT EXAMINER


David Lazaro
October 4, 2005

Continuation Sheet

Continuation of 13. Other:

Explanation of how the new or amended claims would be rejected:

The amended claims, 1 and 12, would be rejected under 35 U.S.C. 103(a) as being unpatentable over Ginzboorg (U.S. Patent 6,047,051) in view of Davis (U.S. Patent 6,389,537). The rejection is essentially the same logic (citations, obviousness, etc) as provided in the previous rejections (as presented in the final office action mailed 05/12/05) of claims 1, 12, 23 and 26. The remaining claims are also rejected based on the logic of the previous rejections with adjustments made accordingly as dictated by the amendment.

Summary of explanation:

Claims 1-4, 6-8, 11-13, 16, 19-22, 27 and 28 are rejected under 103(a) as being unpatentable over Ginzboorg in view of Davis.

Claim 5 is rejected under 103(a) as being unpatentable over Ginzboorg in view of Davis and Melen (U.S. Patent 5,956,391).

Claim 9 is rejected under 103(a) as being unpatentable over Ginzboorg in view of Davis and Roden (U.S. Patent 5,970,477).

Claims 10, 14, 15 are rejected under 103(a) as being unpatentable over Ginzboorg in view of Davis and Cockrill (U.S. Patent Application Publication 2002/0059114).

Claim 17 is rejected under 103(a) as being unpatentable over Ginzboorg in view of Davis and Reeder (U.S. Patent 5,852,812).

Claim 18 is rejected under 103(a) as being unpatentable over Ginzboorg in view of Davis and Kimura (U.S. Patent 5,778,189).

Claims 24 and 25 are rejected under 103(a) as being unpatentable over Ginzboorg in view of Davis and Schutte (U.S. Patent 5,319,454).

Response to arguments:

Applicants state on page 7 of the remarks - *"As an initial matter, Applicant is buoyed by the Examiner's recognition of the deficiencies of Ginzboorg, as Ginzboorg does not provide an appropriate bases for the previously posited §102 rejection"*

Examiner's response - It is not clear as to what applicants are referring to as the examiner, in the final office action (which was mailed on August 02, 2005 not on May 12, 2005), maintained the previous grounds of rejection and further expressed disagreement with Applicants' interpretation of the Ginzboorg reference.

Applicants argue on page 8 of the remarks - *"The examiner concedes that Ginzboorg fails to offer some of these limitations as highlighted above, but incorrectly uses Davis to fill this void. Unfortunately, there is no citation provided by the Examiner with respect to Davis"*

Examiner's response - The office action mailed 08/02/2005, clearly provides citations of Davis in reference to the rejection of Claim 26 under 103(a) in view of Ginzboorg and Davis. The rejection was stated as follows:

"Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginzboorg in view of U.S. Patent 6,389,537 by Davis et al. (Davis).

With respect to Claim 26, Ginzboorg teaches all the limitations of Claim 1 but does not explicitly disclose including a prepaid amount provided by an end user of the subscriber terminal. Davis teaches the use of a prepaid amount provided by an end user of a subscriber terminal (Col. 1 lines 24-36). This is a known purchasing scheme in the provisioning of content to users (Col. 1 lines 10-12 and 24-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Ginzboorg and modify it as indicated by Davis such that the method further comprises wherein the subscriber terminal profile includes a prepaid amount provided by an end user of the subscriber terminal. One would be motivated to have this, as it is a simple and known purchasing scheme for use in provisioning of content to users (In Davis: Col. 1 lines 10-12 and 24-36)."

The rejection clearly cites Col. 1 lines 24-35 and lines 10-12 of the Davis reference.

Applicants argue on page 8 of the remarks *"Notwithstanding this oversight, Davis is still not relevant to the patentability of the pending claims because it fails to offer a pre-paid amount provided in a subscriber terminal for billing for content in a proxy configuration, as outlined by the pending claims. (Applicant has reviewed Davis in its entirety to confirm this contention.) Indeed, Davis provides' no disclosure of a proxy architecture that offers any ability to generate billing information related to the content, which includes accessing a subscriber terminal profile that includes a prepaid amount provided by an end user of the subscriber terminal."*

Examiner's response - Applicants' arguments are essentially conclusive statements as no factual evidence is provided as to how the claimed subject matter is distinguished from the combined teachings of Ginzboorg and Davis.

The 102 rejection of Claim 23 under Ginzboorg as recited in the final office action provides for a proxy architecture that offers the ability to generate billing information

related to the content including the accessing of a subscriber terminal profile (See pages 3 and 7 of the final office action). The rejection of Claim 26 indicates Ginzboorg does not disclose a prepaid amount, but shows that such a limitation is obvious in view of the teachings of Davis. Col. 1 lines 24-35 of Davis, cited in the rejection of Claim 26 and discussed above, states in part *"Upon receiving authorization, the movie is downloaded and, in accordance with one purchasing scheme, an appropriate charge is debited from a **prepaid balance** maintained by the digital platform. This purchasing scheme is referred to as "metered content". When the **prepaid balance** has been exhausted, the customer initiates contact with the content provider or an independent third-party source to establish additional credit."* (emphasis added). It is clear that Davis teaches the feature related to a prepaid amount provided by an end user of a subscriber terminal. When considering Ginzboorg in view of the teachings of Davis as established by the rejection of Claim 26, this limitation is established as being obvious.

Overall, applicants do not seem to be considering the combination as a whole. The examiner reminds the applicants that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants argue on page 8 of the remarks - *"Moreover, Davis appears to be so disparate in its teachings and its architecture that a strong argument could be made that it is simply not analogous art"*

Art Unit: 2155

Examiner's response - Applicants' argument is merely a conclusive statement that provides no factual evidence or reasoning. Clearly the claimed subject matter is related to providing content and generating billing information; from claim 1, "*A method for providing a piece of content to a subscriber terminal...*" and "*generating billing information related to the content*". Davis also describes subject matter related to providing content and generating billing information; Col. 1 lines 25-32 "*a customer issues a request to a content provider...to download a movie to the digital platform*" and "*an appropriate charge is debited from a prepaid balance maintained by the digital platform*". The examiner does not see how Davis is not analogous art and applicants provide no evidence in support of their argument.